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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HUYNH, SON P

ART UNIT PAPER NUMBER

2611

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7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,902

Applicant(s)

WALKER ET AL.

Examiner

Son P Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41 and 47-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41 and 47-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2.4</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 53-57, 59-61, 77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-11, 26, 27 of U.S. Patent No. 6,263,505. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 15 of the application broadly recites the patent claim 7. It also recites an additional limitation "determining the requested supplemental information." Patent claim 7 recites processing the request for the supplemental information by having the CPU in the data processing apparatus execute the program." Necessarily, the requested supplemental information is determined. Therefore it would have been obvious to one of

ordinary skill in the art to modify patent claim 7 in order to obtain the application claim 53.

Allowance of claim 53 would result in an un-warranted time wise extension of the monopoly granted for the invention as defined in claim 7 of patent number 6,263,505.

Claim 54 corresponds to patent claim 8.

Claim 55 corresponds to patent claim 9.

Claim 56 corresponds to patent claim 10.

Claim 57 corresponds to patent claim 11.

Claim 61 corresponds to patent claim 26.

Claim 77 corresponds to patent claim 27.

Claim 59 corresponds to patent claim 7 in "computer readable medium". It would have been obvious to embody the procedures of claim 53 in a "computer readable medium" in order that the instructions could be automatically performed by a processor.

Claim 60 corresponds to patent claim 7 in "an apparatus" with computer readable medium. It would have been obvious to use an apparatus comprise a processor; and "computer readable medium" in order to perform the procedures of claim 7 automatically.

Allowance of claims 53-57, 61, 77, 59, 60 would result in an un-warranted time wise extension of the monopoly granted for the invention as defined in claims 7-11, 26, 27 of patent number 6,263,505.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 41, 47-71, 75-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Shoff et al. (US 6,240,555).

Regarding claim 41, Shoff teaches a method for receiving supplemental information, comprising the steps of:

initiating a computer program (col. 9, line 30+);

receiving program identification and synchronization information related to a video program (receiving data structure 48 and digital data which comprise program title, program time, timing information to synchronize presentation of the supplemental content with the video content program, etc.- figure 3 and col. 5, line 60-col. 7, line 7, col. 9, line 2+);

processing the program identification and the synchronization information (the server produces data structure 48 which comprises program identification and timing

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information to synchronize supplemental information with primary content program and provide the data structure to the viewer computing unit -col. 5, line 5+. The viewer computing unit checks the appropriate channel and time slot of the EPG data structure 48 to determine if the program being carried on the selected channel at this time is interactive (col. 8, line 62+);

receiving from a server (22 or 86 – figure 4) the supplemental information synchronized to the events and action of the video program (receiving supplemental information associated with the primary content video from supplemental content 54 or supplemental content 86 – figure 4 and col. 5, line 15+);

displaying the supplemental information (figure 8c),

in which processing comprises: transmitting the program identification information and the synchronization information to the server (the interactive icon 204, which is displayed on the screen, is manually or automatically activated. This causes the browser 106 to start the target resource located by the target specification listed in the EPG data structure, the supplemental content is retrieved from the supplemental content storage and provided to viewer computing unit for displaying on the screen – col. 9, line 6+ and figures 3-7. Inherently, the identification information and the synchronization information are transmitted to the server so that the server retrieves and provides the supplemental information to viewer.)

Regarding claim 47, Shoff teaches the supplemental information comprises at least one of audio and visual information (col. 5, line 16+).

Regarding claim 48, Shoff discloses display layout may be altered automatically as part of the timing information. For instance, the digital data might invoke a graphic or text to pop up on the screen at a timely point in the program. Such real time content includes, for example, trivia question, interesting facts, graphical or sound effects, and so forth that relate to specific parts of the programs (col. 11, line 48+). Necessarily, the synchronization information comprises a time code, which is update at predetermined intervals.

Regarding claim 49, Shoff teaches a method as discussed in the rejection of claim 48. Shoff further discloses the computer program is used to run the operation of the system (figure 5). As a result, the computer program is adapted to update the time code at the predetermined intervals.

Regarding claim 50, Shoff discloses providing supplemental content relate to program (figure 3). Soft buttons 218-220 enable selection of different types of supplemental content. The user selects soft button 220 to display a merchandise store. The supplemental content comprises a secondary menu having soft buttons 232-237. The cursor symbol 224 is movable among the various buttons and used to activate a selected button. The buttons correspond to various type of merchandise, such as clothes, posters, toys, etc. (col. 12, line 7+). As a result, a request to interactively

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change the supplemental information based upon the video program is transmitted; and the changed supplemental information in accordance with the request is received.

Regarding claim 51, Shoff discloses a method as discussed in the rejection of claim 41.

Shoff further discloses the viewer computer runs an operation system 101 which supports multiple applications. The operations system 101 is stored in memory and executes on the processor (col. 8, line 19+). Necessarily, a computer readable medium storing instructions configured to direct a processor to perform the method of claim 41.

Regarding claim 52, Shoff teaches an apparatus comprising: the computer readable medium of claim 51 in communication with the processor as discussed in the rejection of claim 51; and a processor (92- figure 5).

Regarding claim 53, Shoff teaches a method comprising:

receiving a request for supplemental information related to a video program (activating icon 204 manually or automatically – col. 9, line 54+);

receiving synchronization information related to the video program (receiving request/timing information to synchronize the supplemental information with the primary program content – col. 10, line 1+);

determining the requested supplemental information (the browser 106 starts the target resource located by the target specification listed in the EPG data structure – col. 9, line 56+);

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synchronizing the requested supplemental information to the video program using the synchronization information (col. 10, line 46+); and
transmitting the requested supplemental information (col. 10, line 18+).

Regarding claim 54, Shoff teaches the requested supplemental information comprises audio and visual information (col. 5, line 15+).

Regarding claim 55, Shoff discloses data structure 48 comprises program title, channel, associated supplemental information, etc. is provided to viewer computing unit (figure 3). Interactive icon is activated and supplemental information associated with the selected icon is provided to user (col. 9, line 45+). Necessarily, the identification information (program time, channel, icon 204, etc. is determined prior to determining the requested supplemental information.

Regarding claim 56, the limitations as claimed correspond to the limitations as claimed in claim 48, and are analyzed as discussed in the rejection of claim 48.

Regarding claim 57, Shoff teaches receiving additional requests to interactively change the requested supplemental information based upon the video program (e.g. receiving request to change the button correspond to clothes – col. 12, line 7+ and figure 8c); changing the requested supplemental information in accordance with the additional requests (e.g. changing the layout to display clothes – figure 8c and col. 12, line 7+).

Regarding claim 58, Shoff teaches verifying that synchronization is maintained with the video program (verifying if the target specifications data field 58 is left empty or entered with target resource – figure 3 and col. 6, lines 50-67, col. 8, line 64+).

Regarding claim 59, Shoff discloses a method as discussed in the rejection of claim 53. Shoff further discloses the viewer computer runs an operation system 101 which supports multiple applications. The operations system 101 is stored in memory and executes on the processor (col. 8, line 19+). Necessarily, a computer readable medium storing instructions configured to direct a processor to perform the method of claim 53.

Regarding claim 60, Shoff teaches an apparatus comprising: a processor (92-figure 5); the computer readable medium of claim 59 in communication with the processor (col. 8, line 35+).

Regarding claim 61, Shoff discloses displaying program and icon or other indicia that allow supplemental information to be synchronized with the program when the icon is activated (col. 9, line 30+ and figures 8b-8c). The program might include traditional broadcast TV shows, movies, games, and the like (col. 4, lines 18-22). The EPG may also include other program descriptive information, including whether the program is provided in closed caption or stereo (Col. 4, line 35+). The icon or indicia can be manually or automatically activated. Supplemental contents, which relate to the

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program, from local storage, head end or service provider are received and synchronized with the program and displayed at the viewer computing unit (col. 9, line 35+ and figures 4-8c). Necessarily, the method comprising:

displaying a video program on a display device (200 – figures 8b-8c), in which the video program includes an audio component, a visual component and synchronization information (e.g. icon or indicia);

requesting supplemental information (activate the icon);

transmitting information corresponding to the synchronization information (e.g. transmitting request/digital data in response to the selection of the icon);

receiving the supplemental information synchronized to the video program (receiving supplemental associated with the selected icon from headend, service provider or local storage); and

displaying the supplemental information (displaying supplemental content).

Regarding claim 62, Shoff teaches the display device (66- figure 4) is integrated with a data processing apparatus (viewer computing unit -figure 4).

Regarding claim 63, Shoff teaches displaying the supplemental information comprises: displaying the supplemental information via the data processing apparatus (viewer computing unit receives supplemental information and display the supplemental information on the display screen – col. 7, line 50+).

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Regarding claim 64, Shoff teaches the supplemental information is received via a communication network (74 or 82 – figure 4).

Regarding claim 65, Shoff teaches the visual component of the video program contain the synchronization information (icon or indicia on the screen – col. 9, line 35+).

Regarding claim 66, Shoff discloses icon 204 can be displayed throughout the program, or faded out after a set time period. The icon could be activated to synchronize the supplemental information with the program (col. 9, line 45+). Necessarily, the synchronization information comprises a time code that is changed at predetermined intervals and which is used to synchronize the supplemental information to the video program.

Regarding claim 67, Shoff teaches the video program is selected from the group consisting of: a live television broadcast, and a prerecorded television broadcast (col. 4, line 17+).

Regarding claim 68, Shoff discloses the supplemental information can be automatically displayed in response to launching the Internet browser (col. 3, lines 20-27). The supplemental content is stored digitally in database 54 (col. 5, line 15+). Thus, the supplemental information is received from a computer readable medium.

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Regarding claim 69, Shoff teaches the computer readable medium is a CD-ROM (the interactive content can be supplied locally by a storage medium, such as a CD-ROM (col. 7, line 60+).

Regarding claim 70, Shoff teaches the visual component of the video program contains program identification information related to the video program (e.g. program title 228 – figure 8b).

Regarding claim 71, Shoff teaches making additional requests to change, interactively, the requested supplemental information (e.g. user select button correspond to clothes to display the clothes – figure 8c and col. 12, line 7+).

Regarding claim 75, Shoff discloses a method as discussed in the rejection of claim 61. Shoff further discloses the viewer computer runs an operation system 101 which supports multiple applications. The operations system 101 is stored in memory and executes on the processor (col. 8, line 19+). Necessarily, a computer readable medium storing instructions configured to direct a processor to perform the method of claim 61.

Regarding claim 76, Shoff teaches an apparatus comprising: a processor (92-figure 5); the computer readable medium of claim 75 in communication with the processor (col. 8, line 35+).

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Regarding claim 77, Shoff discloses displaying program and icon or other indicia that allow supplemental information to be synchronized with the program when the icon is activated (col. 9, line 30+ and figures 8b-8c). The program might include traditional broadcast TV shows, movies, games, and the like (col. 4, lines 18-22). The EPG may also include other program descriptive information, including whether the program is provided in closed caption or stereo (Col. 4, line 35+). The viewer computer runs an operating system 101, which supports multiple applications. The operating system 101 employs a graphical user interface windowing environment which presents the applications or documents in specially delineated areas of the display screen called "windows" (col. 8, line 19+). Viewing the supplemental content is initiated in several ways (col. 9, line 30+). The icon or indicia, displayed on the screen, can be manually or automatically activated. Supplemental content from local storage, head end or service provider are received and synchronized with the program and displayed at the viewer-computing unit in response to the selection of the icon (col. 9, line 35+ and figures 4-8c).

Necessarily, the method comprising:

displaying a video program on a display device (200 – figures 8b-8c), in which the video program includes an audio component, a visual component and synchronization information (e.g. icon or indicia);

initiating a computer program adapted to process a request for supplemental information related to the action and events occurring within the video program

(initiating a computer program, in viewer computing unit, adapted to process a request

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for supplemental information related to the activating of icon manually or automatically based on timing information);

requesting supplemental information (activate the icon for supplemental content);

transmitting information corresponding to the synchronization information (e.g. transmitting request/digital data in response to the selection of the icon);

receiving the supplemental information synchronized to the video program (receiving supplemental associated with the selected icon from headend, service provider or local storage); and

displaying the supplemental information (displaying supplemental content).

Regarding claim 78, Shoff teaches a method as discussed in the rejection of claim 77. Shoff further discloses the viewer computer runs an operation system 101 which supports multiple applications. The operation system 101 is stored in memory and executes on the processor (col. 8, line 19+). Shoff further discloses in response to the activation of the icon, the supplemental content, which associated with the activated icon, from headend or service provider is provided to viewer computing unit and synchronized with the program content (col. 9, line 54+). Necessarily, the computer program is adapted to transmit the request for the supplemental information via a computer network interface (e.g. modem 100 – figure 5) to a server (supplemental content source – figures 4-5), and in which the server transmits, in response, the requested supplemental information.

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Regarding claim 79, Shoff teaches a method as discussed in the rejection of claim 77.

Shoff further discloses the supplemental content source provides supplemental that associated with the selected information to the viewer-computing unit and synchronize the supplemental content with the program being watched (col. 9, line 55+).

Necessarily, the computer program is adapted to transmit identification information and the synchronization information via a computer network interface (e.g. modem 100 – figure 5) so that the supplemental content source retrieves the desired data associated with the currently displayed program and provides it the viewer computing unit to synchronize it with a predetermined point of the program.

Regarding claim 80, Shoff teaches the method as discussed in the rejection of claim 77.

Shoff further discloses the user can select different buttons correspond to different products on the screen to change the display to the product associated with the selected button (figures 8a-8c and col. 12, line 10+). Inherently, the computer program is adapted to make additional requests to interactively change the supplemental information.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al. (US 6,240,555) in view of Knee et al. (US 6,014,184).

Regarding claim 72, Shoff teaches a method as discussed in the rejection of claim 61.

Shoff further discloses an order button 237 that permits the user to place an order for a particular product (col. 12, line 17+). However, Shoff does not specifically disclose initiating payment.

Knee teaches initiating payment (figure 43c). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shoff to use the teaching as taught by Knee in order to improve convenience for user to purchase product.

Regarding claim 73, Shoff teaches a method as discussed in the rejection of claim 61.

Shoff further discloses an order button 237 that permits the user to place an order for a particular product (col. 12, line 17+). However, Shoff does not specifically disclose initiating payment comprises providing payment using a credit card account.

Knee teaches initiating payment comprises providing payment using a credit card account (figure 43c and col. 37, line 20+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shoff to use the teaching as taught by Knee in order to improve convenience for user to purchase product.

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Regarding claim 74, Shoff teaches a method as discussed in the rejection of claim 61.

Shoff further discloses an order button 237 that permits the user to place an order for a particular product (col. 12, line 17+). However, Shoff does not specifically disclose

initiating payment comprises providing payment of a service statement.

Knee teaches initiating payment comprises providing payment of a service statement

(add the purchase price to the user's bill for program services - figure 43c and col. 37,

line 25+). Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Shoff to use the teaching as taught by Knee in

order to improve convenience for user to purchase product.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fries (US 6,317,885 B1) teaches interactive entertainment and information system using television set top box.

Feinleib (US 6,637,032 B1) teaches system and method for synchronizing enhancing content with a video program using closed captioning.

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Ahmad et al. (US 6,263,507 B1) teaches browser for use in navigating a body of information, with particular application to browsing information represented by audiovisual data.


Slezak (US 6,006,257) teaches multimedia architecture for interactive advertising in which secondary programming is varied based upon viewer demographics and content of primary programming.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son P. Huynh
July 7, 2004



VIVEK SRIVASTAVA
PRIMARY EXAMINER